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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/392,406	09/09/99	PINEIRO	J T1427

000210  
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HM22/0309

EXAMINER

LAMBKIN, D

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 03/09/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/392,406

Applicant(s)

Pineiro et al

Examiner

Deborah Lambkin

Group Art Unit

1626

☒ Responsive to communication(s) filed on Jan 19, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-16, 18, and 19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-16, 18, and 19 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-16, 18, and 19 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1613

***Election/Restriction***

Applicant's election with traverse of Group I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the fifteen groups are an undue burden on applicant with respect to time and cost to file fourteen divisionals. This is not found persuasive because applicant did not point out any errors in the restriction requirement, however in view of the prior art found, Groups I-X and XI-XV would be combined as Groups I and II, respectively.

The requirement is still deemed proper and is therefore made FINAL.

Consequently, claims 1-16 and 18-19 were examined solely to the extent in which they read on compounds of Formulas I and II.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 contains several recitations of the word "including" which is indefinite claim language.

Art Unit: 1613

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fuji et al.

Fuji et al teach the intermediate, dipropylamino-ethyl-phenylsulfonyl-indol-ol, for preparing alkyl-substituted indoles which read in the instant genus of formula I when R1, R2 is alkyl, n is 1, R5 is OH, R3 is H and R4 is arylsulphonyl.

Claims 1, 5 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbst '953 .

Herbst teaches antidepressive aryl-sulfonyl-ethyl indoles listed in col.1, lines 50-70 and col.2, lines 1-5 which read on the instant genus of formula 11 when A-B is CH=CH, R3 is H, q is 0, R1, R2 is alkyl or together is pyrrolidino, piperidino or morpholino and R4 is arylsulphonyl, substituted or unsubstituted, wherein depression reads on a condition mediated by 5-HT.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1613

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbst '953.

Herbst teaches a genus of arylsulfonyl-ethyl indoles antidepressants which embrace some of the instant species as described above.

It would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to choose a species from a prior art genus motivation being that said species would be expected to possess the same or similar properties as its exemplified counterparts, in this case, as antidepressants, absent some unobvious or unexpected results.

Claims 1, 3-4, 11-13, 15-16 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herbst.

Herbst teaches arylsulfonyl-ethyl indoles having antidepressant activity which are positional isomers of the compounds of formula I as described above.

It would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to prepare positional isomers of the known compounds of Herbst et al motivation being that positional isomers are known to be obvious variants and therefore equivalents with the expectation that they too would possess the same or similar properties as their exemplified counterparts, absent some unobvious or unexpected results.

Art Unit: 1613

Claims 1-3, 7-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slassi et al (WO '516) in view of Herbst.

Slassi et al teach next adjacent homologs of the instant compounds for the same use, that is where the pyrrolidino is attached to the indole via a methyl versus the instant ethyl chain.

Herbst teaches analogous compounds having similar antidepressant activity wherein upon changing the methyl chain to a ethyl chain, the antidepressant activity was maintained.

It would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to prepare next adjacent homologs of the prior art compounds of Slassi et al motivation being that next adjacent homologs are obvious variants to the ordinary skilled artisan as evidenced by Herbst, with a reasonable expectation that they too would possess the same or similar activity as their exemplified counterparts, absent some unobvious or unexpected results.

Claims 1-3, 9-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Herbst and Slassi et al in view of Gaster et al '122.

Herbst teaches arylsulfonyl-ethyl indoles having antidepressant activity which differ from the instant compounds by having an indole ring instead of the instant indoline ring and in some cases substitution on the phenyl portion of the indole.

Slassi et al teach that the indole ring in compounds analogous to those of Herbst et al can be substituted with some of the instant substituents on the phenyl ring wherein the antidepressant activity is maintained and also which possess 5-HT activity.

Art Unit: 1613

Gaster et al teach analogous 5-HT receptor antagonist wherein the heteroaryl group can be attached directly to an indole or indoline ring wherein the 5-HT activity is maintained; in other words, Gaster teach the art recognized equivalence of indole and indoline in similar 5-HT antagonists.

It would have been prima facie obvious to one having ordinary skill in the art at the time the application was filed to modify the indole ring to an indoline ring or substituted indole in the compounds of Herbst and Slassi et al motivation being that indole and indoline and their substituted counterparts are considered to be art recognized equivalents as evidenced by Gaster et al and therefore expected to possess the same or similar activity upon interchangeability, absent some unobvious or unexpected results.

No unobvious or unexpected results are seen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lambkin whose telephone number is (703) 308-4522.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Dcl406

*Deborah C. Lambkin*  
DEBORAH C. LAMBKIN  
PRIMARY EXAMINER